

Notice of Allowability	Application No.	Applicant(s)	
	10/714,126	MARION ET AL.	
	Examiner	Art Unit	
	Alex B. Toy	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed on 9 December 2005.
2. ☒ The allowed claim(s) is/are 1-11, 28-43, 59, and 70-94.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| <ol style="list-style-type: none"> 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>11/13/03</u> 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <ol style="list-style-type: none"> 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. 7. <input type="checkbox"/> Examiner's Amendment/Comment 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance 9. <input type="checkbox"/> Other _____. |
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DETAILED ACTION

Response to Amendment

This action is in response to applicant's amendment filed on December 9, 2005. The double patenting rejection of claims 1-12, 20, 28-43, and 59 is withdrawn in view of the terminal disclaimer filed on December 9, 2005. The Ein-Gal 102(e) rejection of claims 12 and 20 is withdrawn in view of applicant's cancellation of these claims.

Allowable Subject Matter

Claims 1-11, 28-43, 59, and 70-94 are allowed.

Reasons for Allowance

The following is a statement of reasons for the indication of allowable subject matter:

Regarding independent claim 1, there are several references in the prior art that are relevant but do not clearly set forth the method steps as claimed.

Eggers (U.S. Pat. No. 6,471,659 B2) discloses monitoring for an electrical characteristic to determine when an arc has been initiated (col. 58, ln. 42-67). However, the arc is only initiated in response to a boost interval (col. 58, ln. 19-25). Since the boost energy is described as an interval, it is not clear that the boost energy constitutes initiating the delivery of energy and not a previous base level of energy. In addition, the device of Eggers is a stationary tissue sampling probe, and it would not be obvious to move the electrode once the arc has been detected.

Lindenmeier (U.S. Pat. No. 6,022,347) discloses monitoring for an electrical characteristic to determine when cutting has commenced (col. 7, ln. 40-55). However, it is not clear that Lindenmeier is monitoring in order to determine the point of arc initiation prior to moving the electrode in removing a probe from the tissue (col. 7, ln. 11-32). In addition, a coagulation stage occurs prior to the cutting mode used to remove the probe from the tissue (col. 6, ln. 18-22). Therefore, it is not clear that the energy used to form the cutting arc constitutes initiating the delivery of energy.

Schilling (U.S. Pat. No. 5,976,128) discloses monitoring for an electrical characteristic to determine when an arc has been initiated (col. 3, ln. 26-32). However, Schilling does not disclose the step of moving the electrode once the arc has been detected.

Regarding independent claims 28, 43, and 59, Ein-Gal (U.S. Pat. No. 6,497,704 B2) discloses a controller 32 that controls the movement of an electrode (col. 8, ln. 42-56 and Figs. 1 and 6A). However, Ein-Gal and the prior art do not disclose or suggest a controller that detects arc initiation and then initiates movement of an electrode upon arc initiation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AT *AT*
1/10/06

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER